



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/579,808

05/16/2006

Jean-Marie Bernard

RN03179

5954

7590
Jean-Louis Seugnet
Rhodia Inc.
8 Cedar Brook Drive
Cranbury, NJ 08512-7500

02/19/2008

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

02/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,808	Applicant(s) BERNARD ET AL.	
	Examiner Patrick D. Niland	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-23 and 25-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 25-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/26/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1796

1. The amendment of 11/26/07 has been entered. Claims 20-23 and 25-50 are pending.

2. Claims 20-23, 25-34, and 38-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. The newly amended claims 20-23, 25-34, and 38-48 require “with the proviso that” when the compounds have at least one biuret bond and at least one aminoalkoxysilane unit, the amine functional group inserted in the at least one biuret is bonded to at least one aminoalkylsilane unit.” There is not support in the originally filed specification for this language. It appears from the entirety of page 15, particularly the formula at line 10, that the aminoalkoxysilane unit's amino group forms the NRH unit of the biuret group. The amino group of the aminoalkoxysilane unit is therefore part of the biuret group. The amine functional group inserted in the at least one biuret is not bonded to at least one aminoalkylsilane unit, as claimed therefore. The new limitation is new matter because it is not supported in the originally filed specification.

3. Claims 20-23 and 25-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The newly amended claims 20-23, 25-34, and 38-48 require “with the proviso that” when the compounds have at least one biuret bond and at least one aminoalkoxysilane unit, the amine functional group inserted in the at least one biuret is bonded to at least one aminoalkylsilane

Art Unit: 1796

unit.” There is not antecedent basis for “the amine functional group inserted in the at least one biuret”. It is therefore unclear what is intended by this limitation specifically such as it is unclear whether this references the diamino compound or some other amine compound that is not further specified in the claims and it is unclear where this additional amine functional group is inserted on the biuret. Is it an amine to be reacted with the NCO of the biuret compound or some other amine functional group? The scope of the claim is rendered unclear by the lack of antecedent basis.

B. The preamble of claim 35 references biuret functional groups. The recited method does not require any biuret functional groups in the recited reactants nor their formation. There is no process step recited that makes the argued biuret group.

It is therefore unclear whether the claimed method requires the preamble limitation regarding biuret groups or is intended to have the full scope of the method claimed after the preamble, which does not require biuret groups. The applicant argues that the method requires the presence of a biuret group as defined in the specification. It is impermissible to read limitations from the specification into the claims. Given the Court’s recognition that the applicant can be their own lexicographer, the lack of specific method steps or ingredients containing biuret, the claim language scope remains unclear for the above reasons.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 35-37 and 49-50 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 62-250021 A Yamakado.

Yamakado discloses reaction products of polybiurets of HDI with the instantly claimed amounts of aminoalkylalkoxysilanes which fall within the scope of the instant claims. See the formulae on pages 142 of the Japanese document and the description in the English abstract. Polymer reactions cannot give only the idealized formulae of page 142 of the Japanese document though this product is that of the instant method claims. The biurets appear to not contain the aminoalkoxysilane directly attached to the biuret group itself, which meets the limitations of claim 36. A mixture of molecules will form as is understood from the definitions of the polymer concepts such as average molecular weight, average functionality, and the physical factors that govern polymerizations including the statistics of such reactions. Thus the reaction mixture of the reference is expected to necessarily and inherently possess molecules meeting the limitations of the instant claims since such molecules having more than one silane functionality must necessarily form to some degree. The above discussed composition and method of making it reads on the limitations of the instant claims.

The applicant's argument that the instant claims require reacting an isocyanate monomer with the aminosilane, not an oligomer is not persuasive. The trimer isocyanate of the reference falls within the scope of a monomer as "monomer" is used in this art. Oligomers may also be considered monomers by virtue of being "macromonomers" which fall within the broad class of "monomers". The claim language does not specifically exclude the trimers of the reference from the scope of isocyanate monomers. This argument is therefore not persuasive. The rejection is maintained for the above claims.

6. Claims 20-23, 25-34, and 38-48 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action. The prior art does not disclose these claimed inventions nor provide rationale to modify the prior art disclosures into these inventions.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner,
Art Unit 1796